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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/682,574	09/21/2001	Edward Panelli	GEMS:0112/YOD 15-EC-5739	1965
7590 Patrick S. Yoder Suite 330 7915 FM 1960 West Houston, TX 77070			EXAMINER HAQ, NAEEM U	
			ART UNIT 3625	PAPER NUMBER
			MAIL DATE 05/23/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/682,574

Applicant(s)

PANELLI ET AL.

Examiner

Naeem Haq

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-16, 19-24 and 30-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-16, 19-24 and 30-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This action is in response to the Applicants' amendment filed on February 28, 2007. Claims 1-9, 11-16, 19-24, and 30-37 are pending and will be considered for examination.

Applicants' amendment to claim 1 is sufficient to overcome the rejection of claims 1-9 and 11-16 under 35 U.S.C. 101 and 112, second paragraph. These rejections are withdrawn.

Final Rejection

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Art Unit: 3625

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-4, 6, 11, 13, 15, 19, 21, and 30-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Langseth et al. (US 6,694,316 B1) ("Langseth").

Referring to claims 1, 2, 6, 11, 13, 15, 19, 21, 30, 31, and 34: Langseth teaches an electronic information system, comprising at least one programmed computer that is accessible electronically via an electronic communication system (col. 4, lines 11-21; col. 15, lines 14-20), wherein the electronic information system is operable to enable a customer to access the electronic information system via the electronic communication system to electronically create a standing order of a customer specified duration for periodic delivery to a specified customer location of a product, good, or service (col. 13, lines 10-47; col. 26, lines 24-51).

Referring to claims 3, 4, 32, and 33: Langseth teaches all the limitations of claim 1 as noted above. Furthermore, Langseth teaches that the electronic information system is operable to enable the customer to access the electronic information system via the electronic communication system and identify electronically the product, good, or service to be delivered periodically under the standing order (col. 26, lines 24-35).

Art Unit: 3625

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 7, 23, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Langseth et al. (US 6,694,316 B1) ("Langseth") in view of Meissner et al. (US 6,070,001) ("Meissner").

Referring to claims 5, 7, 23, and 35: Langseth teaches all the limitations of claim 1 as noted above. Langseth does not teach enabling the customer to revise the product, good, or service to be delivered periodically under the standing order. However, Meissner teaches a system that lets a customer add or delete (i.e. revise) services (e.g. channels) to a subscription (col. 8, lines 19-25). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Meissner into the system of Langseth. One of ordinary skill in the art would have been motivated to do so in order to allow a customer to add or delete services from their subscription, as taught by Meissner.

Claims 8, 9, 20, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Langseth et al. (US 6,694,316 B1) ("Langseth") in view of Schiller et al. (US 6,442,573 B1) ("Schiller").

Referring to claims 8, 9, 20, and 36: Langseth teaches all the limitations of claim 1 as noted above. Langseth does not teach enabling a customer to establish or revise

Art Unit: 3625

the frequency of delivery of a product, good, or service to be delivery periodically under the standing order. However, Schiller teaches a system that allows a user to change weekly subscription to monthly subscription (col. 22, lines 57-65). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into the system of Langseth. One of ordinary skill in the art would have been motivated to do so in order to allow a user to change the subscription delivery, as taught by Schiller.

Claims 14 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Langseth et al. (US 6,694,316 B1) ("Langseth") in view of Wiecha (US 5,870,717).

Referring to claims 14 and 22: Langseth teaches all the limitations of claim 1 as noted above. Langseth does not teach enabling a customer to review a standing order for periodic delivery. However, Wiecha teaches a system for ordering items over a network that allows a user to review a purchase order (col. 3, lines 45-47). The Applicant's specification discloses that a standing order is a type of purchase order. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Wiecha into the system of Langseth. One of ordinary skill in the art would have been motivated to do so in order to allow a user to make changes as necessary to the purchase order.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Langseth et al. (US 6,694,316 B1) ("Langseth") in view of Official Notice.

Art Unit: 3625

Referring to claim 12: Langseth discloses all the limitations of claim 11 as noted above. Langseth does not disclose that the electronic information system requires the customer to provide an authorization identifier before enabling the customer to create the standing order. However, Official Notice is taken that it is old and well known in the art to use a username and password as a form of authorization identifier. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate a username and password (i.e. authorization identifier) in the invention of Langseth. One of ordinary skill in the art would have been motivated to do so in order to verify the identity of the user prior to allowing the user to transfer his or her funds.

Claims 16, 24, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Langseth et al. (US 6,694,316 B1) ("Langseth") in view of Wallman (US 6,338,047 B1).

Referring to claims 16, 24, and 37: Langseth discloses all the limitations of claim 11 as noted above. Langseth does not disclose that the electronic information system incorporates business rules provided by a supplier for the creation of a standing order, wherein the electronic information system prevents the customer from creating a standing order in violation of the business rules. However, Wallman teaches a system for creating a standing order that incorporates business rules provided by a supplier for the creation of a standing order, wherein the electronic information system prevents the customer from creating a standing order in violation of the business rules. (col. 6, lines 32-46; Figure 3, items "350"). Therefore it would have been obvious to one of ordinary

Art Unit: 3625

skill in the art, at the time the invention was made, to incorporate the teachings of Wallman into the invention of Langseth. One of ordinary skill in the art would have been motivated to do so in order to ensure that the standing order was created in accordance with the supplier's business rules, as taught by Wallman.

Response to Arguments

Applicants' arguments have been fully considered but they are not persuasive. The Applicants have argued that Langseth does not teach creating a standing order of customer specified duration. According to the Applicants, Langseth teaches that the service provider and not the customer set the duration. The examiner respectfully disagrees. Langseth explicitly teaches that the duration is set by the customer sets the duration (e.g. see col. 26, lines 44-47: "*Also, if monthly fees are charged, the fees may be pro rated depending on when the user subscribes or terminates a subscription in the monthly billing cycle for the service.*") For this reason, the examiner maintains the art rejection.

The Examiner notes that the Applicants did not respond to the Examiner's Official Notice rejection of claim 12 in the previous Office Action. In order to adequately traverse a rejection based on common knowledge (i.e. Official Notice), Applicants must specifically point out the supposed errors in the Examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. A general allegation that the claim defines a patentable invention without any reference to the Examiner's assertion of Official Notice is inadequate. In the present case, the Applicants did not respond to the Examiner's rejection using Official Notice.

Art Unit: 3625

Furthermore, the Applicants failed to argue why the noticed fact is not considered to be common knowledge or well-known in the art. Instead, the Applicants have provided a general allegation of patentability of claim 12. For this reason, Applicants' response is considered to be an inadequate traversal of the Official Notice used by the Examiner in the rejection of claim 12 under 35 U.S.C. §103.

Since the Applicants have failed to seasonably challenge the Examiner's Official Notice presented in the previous Office Actions, the Examiner now interprets all Official Notices as admitted prior art. *Applicant must seasonably challenge well known statements and statements based on personal knowledge when they are made. In re Selmi, 156 F.2d 96, 70 USPQ 197 (CCPA 1946). If Applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d71, 60 USPQ 239 (CCPA 1943). Also see MPEP 2144.03.*

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 3625

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (571)-272-6758. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571)-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NAEEM HAQ
PRIMARY EXAMINER

May 19, 2007

